

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark D. Scott, et al. Examiner: R. Hayes
Serial No. 09/323,765 Group Art Unit: 1647
Filed: June 1, 1999 Docket No. 259.006US1
Title: ANTIGENIC MODULATION OF CELLS

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Alexandria, VA 22313-145

PETITION TO REVIVE AN UNINTENTIONAL ABANDONMENT
UNDER 37 CFR 1.137(b)

Attention:
Paralegal Specialist
Office of Petitions
MAIL STOP PETITIONS
P.O. BOX 1450
COMMISSIONER FOR PATENTS
Alexandria, VA 22313-145

Dear Sir/Madam:

FACTUAL BACKGROUND

1) Six (6) separate issues are identified as to why the Brief on Appeal is Non-compliant, the items identified as 1), 2), 3), 4), 5) and 8) (*sic*, 6). These items are, as follows:

i) Item 1) The Summary of the claim subject matter still recites "and a method by which cells may be converted...". In contrast, the subject matter is directed to only the product. **This assertion by the PTO is I error. Applicants point to Claims 24, 15 and 26, claim 24 being an independent claims from which claims 25 and 26 ultimately depend, and that claim beginning "A method of producing a non-immunogenic mammalian cell..." This (and the dependent claims) is clearly a Method claim, and the general commentary before mapping out antecedent basis for each limitation in the claims is correct. THIS BASIS FOR ASSERTING THAT THE BRIEF IS NON-COMPLIANT IS CLEARLY IN ERROR.**

Adjustment date: 05/30/2008 CKHLOK
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04/28/2008 EAREGAY1 00000008 501391 09323765
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ii) Item 2) Page 8 of the Brief on Appeal inadvertently referred to the rejection as a 35 U.S.C. 102(e) rejection, even though the heading correctly identified the rejection as a rejection under 35 U.S.C. 103(a). This secondary description of the rejection has been removed. The rejections are now consistently referred to as **Claims 2-7, 18-21, 23-25, 28 and 31 have been rejected under 35 U.S.C. 102(e) as anticipated by Desai et al. (U.S. Patent No. 5,578,442) in light of Lin et al. (1976).**

iii) Item 3) Page 11, lines 20, 22 and 24, as well as page 12, lines 19 of the Brief on Appeal (and elsewhere as identified by Appellant) referred to "virus particles" or "viral particles" in the arguments, although these terms were not in the claims. **Reference to viral particles have been removed from the arguments and "cell" particles or cells used in their stead.**

iv) Item 4) It is asserted that Arguments on page 6 of the Brief (lines 1-2) correctly define the rejection as a 35 USC 102(b) rejection, but the discussion beginning on line 3 describes the rejection as being under 35 USC 103(a). **This erroneous secondary description has been removed. The Brief, beginning at line 3 of the argument over this rejection now states "Claims 1, 4, 8, 10-16, 24 and 26 have been rejected under 35 U.S.C. 102(b) as anticipated by Francis et al. (WO 95/06058)."**

iv) **Item 5)** Appellants are totally confused as to what references are to be cited as part of the "Evidence Appendix" Attorney for Appellants has called the PTO on two occasions, and counsel hired by the Attorney of Record in this case to assist in this Petition and Brief has also called the US Patent and Trademark Office. No statutory or regulatory basis has been identified for requiring that copies of references cited by the PTO in rejections, even if not US Patent references, have to be supplied on Appeal. In addition, the wording, grammar and format construction of this "Issue" is in a manner that the objective of the Examiner is not understood. Applicants are therefore providing copies of each of the four references cited in the rejections on Appeal:

- i) Francis WO 98/32466;
- ii) Desai (US Patent No. 5,578,442);
- iii) Lin and Riggs, "Photochemical Attachment of *lac* Repressor to Bromodeoxyuridine-Substituted *lac* Operator by Ultraviolet Radiation," *Proc. Nat. Acad. Sci.* Vol. 71, No. 3, pp. 947-951, March 1974 (with a communication date of October 27, 1973); and
- iv) Francis et al. (WO 95/06058)

v) Item 8) (*sic*, 6) This Issue asserts that "Except for the Lin reference, none of the listed WO documents in the Evidence section have been made of record, or are they part of the rejections made of record. In addition, no copies of the prior art references relied upon in the rejections made of record have been submitted by Appellant for the Board's consideration."

Again, conference calls to the Board of Appeal by the Attorney of record and review of the Regulations have failed to identify any statutory or regulatory basis for requiring Appellants to submit references used by the PTO in rejections. It is to be further noted that the Examiner is further in error in that at least one rejection of record does include a WO reference. Specifically, the rejections of record include:

A) Claims 1, 4, 8, 10-16, 24 and 26 have been rejected under 35 U.S.C. 102(b) as anticipated by Francis et al. (WO 95/06058); and

B) Claims 1-26, 28 and 31 have been rejected under 35 U.S.C. 103(a) as obvious over the combination of Desai et al. in light of Lin et al. (1976) in view of Francis et al.

Therefore, two rejections of record do include the WO reference WO 95/06058, which under PTO rules, as it was cited by the PTO in a rejection and is of record since cited and used by the PTO. Additionally, even though there is no statutory basis or regulatory basis for requiring a copy of this reference, a copy of each of the four references is being provided, including this reference used in a rejection.

CONCLUSION

Each and every issue raised in the assertion of a Non-Compliant Brief have been discussed and addressed. Some of the Issues raised are **clearly in error** and cannot be corrected as required by the Examiner (e.g., the Invention does include "method claims," so removal of the statement that the claims on Appeal include method claims would be error, even though required by the Examiner.

The descriptions of the rejections on appeal have been corrected.

Copies of each and every reference actually cited in a rejection are provided, even though the Evidence Appendix does not require such submission.

As the documents included with this Petition clearly shows that all formalities for Brief on Appeal of this Application are performed *in good faith* by Attorney for Applicants and timely received by the U.S. Patent and Trademark Office, the Abandonment of this Application is clearly in error, was inadvertent and/or unintentional **OR IN ERROR on the part of the U.S. Patent and Trademark Office, with no error or responsibility by Applicants or their counsel.**

2) DECISION ON PETITION WAS ISSUED ON APRIL 14, 2008 DISMISSING THE EARLIER PETITION FILED AUGUST 27, 2007.

APPLICANTS HERE HAVE SHOWN THAT IN ACCORDANCE WITH THE STATEMENTS IN THE DECISION ON PETITION, THE PRESENT PETITION SHOULD BE GRANTED.

The Decision on Petition states that a Grantable Petition under 37 C.F.R. 1.137(b) must contain:

- 1) The required reply under 1.137(b).
- 2) The Petition set forth in 37 C.F.R. 1.17(m);
- 3) a statement that the entire delay in filing the required replay from the due date for the replay until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and
- 4) any Terminal Disclaimer (and fee) set forth in 37 C.F.R. 1.20(d) required by 37 C.F.R. 1.137(d).

CONTENT OF THIS PETITION AND ATTACHMENTS

1) The required Appeal Brief with all necessary materials was submitted with the Petition on April 24, 2008. A duplicate copy of that Brief is attached hereto and resubmitted with this Petition.

2) The Petition set forth in 37 C.F.R. 1.17(m)

The present document constitutes the Petition set forth in 37 C.F.R. 1.17(m) and the Attorney of Record hereby authorizes debiting of Attorney's deposit Account No. 501391 for the fees at a rate for a SMALL ENTITY (\$750.00), which the assignee is,

(m) For filing a petition for the revival of an unintentionally abandoned application, for the unintentionally delayed payment of the fee for issuing a patent, or for the revival of an unintentionally terminated reexamination proceeding under 35 U.S.C. 41(a)(7) (§1.137(b):

By a small entity (§1.27(a): \$750.00

3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional;

The attorney of record hereby states and declares, with full knowledge and acceptance of the legal penalties for intentional misstatements before the US Patent and Trademark Office that the entire delay in filing the required reply until the filing of the grantable petition pursuant to 37 C.F.R. 1.137(d) was unintentional.

1) As a first point of evidence, whether the Attorney of record has made technical errors in the provision of documents in filing the Brief and the Replacement Briefs and Petitions, the attorney of record has made good faith efforts at filing the appropriate documents, and, since the original Brief Filing, has not billed clients, accepting responsibility for the work without payment. Each and every response has been filed by the Attorney of record.

2) As a second point of reference, even though there was an error in the Replacement Brief(s) and in the previous Petitions, the Attorney of Record unintentionally misunderstood the complete nature of the failure in the original

Replacement Brief or the issues identified by the PTO were in error. This mistake was unintentional.

3) Although the Attorney of record must accept responsibility for the error in the earlier replacement brief, any error were complicated by and contributed to by the misunderstanding of the definition of rejection issues, these have all been corrected.

4) Any deficiencies in the response and the Petition were always unintentional. The fact that the Attorney of Record has persisted in attempting to reach an appeal, with no additional billings to the client.

5) The Attorney of Record feels that the unintentional delay in filing a Brief on Appeal was due to the fact that the Attorney of Record was distracted by repeated efforts of record to avoid preparation of an Examiner's Answer, such as the continuing efforts by the Examiner to hold the case abandoned for not filing "evidence" in the Evidence Appendix Page consisting of references cited and supplied by the Patent and Trademark Office and the assertion that no Method claims are on Appeal. The Attorney of Record admits to being distracted by the repeated and constant barrage of incidental and ambiguously described attacks on form and style raised in the prosecution history. However, these distractions were unintentional and led to the unintentional filing of a Brief that did not respond to one of the many efforts made and issues raised to avoid a decision on the merits.

8) The attorney of Record has repeatedly made a good faith effort to comply with every request and identified issue in the prosecution of this application. The continued response to issues, even if containing the last time, a single unintentional error, shows that any delay in filing a correct Brief on Appeal were unintentional. The attorney of record would have no benefit in failing to file a correct Brief on Appeal and the repeated effort shows that any delay was unintentional.

4) any Terminal Disclaimer (and fee) set forth in 37 C.F.R. 1.20(d) required by 37 C.F.R. 1.137(d).

No Terminal Disclaimer or authorization for debiting of the fee id provided for the fees for this Terminal Disclaimer in accordance with 37 C.F.R. §1.137(b) as it is not applicable in the present case

"...(d) Terminal disclaimer.

(1) Any petition to revive pursuant to this section in a design application must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted thereon equivalent to the period of abandonment of the application.”

The present case is not a Design Application.

5) APPLICANTS herewith submit three copies of what is believed to be a corrected Brief on Appeal and an outline of why the Examiner's position was in error.

PETITION

1) Appellants Petition as follows:

Applicants hereby petition to revive the application due to the fact that any failure or delay in compliance was unintentional. The abandonment of the application was unintentional and/or inadvertent

The contact person is invited to telephone Applicant's attorney (952) 832-9090 if necessary. **If necessary please charge any additional fees to Deposit Account No. 50-1391 for the petition for revive unintentional abandonment under 37 CFR 1.137(b).**


Respectfully submitted,

Mark D. Scott et al.

By their Representatives,

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Edina, MN 55435
(952) 832-9090

Date: April 24, 2008


By 
Mark A. Litman
Reg. No. 26,390
(952) 932-9090

CERTIFICATE UNDER 37 C.F.R. 1.10:

'Express Mail' mailing number: EM 125426698 US

Date of Deposit: 24 April 2008

The undersigned hereby certifies that this Transmittal Letter and the paper or fee, as described herein, are being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 and is addressed to Mail Stop PETITIONS, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313.

By: 
MARK A. LITMAN

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND											
1 Date of Request: <u>5/9/08</u>		2 Serial/Patent # <u>09/323,765</u>									
3 Please refund the following fee(s):		4 PAPER NUMBER	5 DATE FILED	6 AMOUNT							
	Filing			\$							
	Amendment			\$							
	Extension of Time			\$							
	Notice of Appeal/Appeal			\$							
<input checked="" type="checkbox"/>	Petition		4/23/08	\$ 770							
	Issue			\$							
	Cert of Correction/Terminal Disc.			\$							
	Maintenance			\$							
	Assignment			\$							
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10 REASON:		8 TO BE REFUNDED BY:									
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<i>Petition fee already paid</i>											
11 REFUND REQUESTED BY:											
TYPED/PRINTED NAME: <u>Carl Friedman</u>		TITLE: <u>Petitions Examiner</u>									
SIGNATURE:		PHONE: <u>2-6842</u>									
OFFICE: <u>Office of Petitions</u>											
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APPROVED:		DATE: <u>5/30/08</u>									

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